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Paper No. 14
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gruber Systems, Inc.
v.
Grantex Surface Systems

Opposition No. 113,374
to application Serial No. 75/451,964
filed on March 17, 1998

Michael D. Harris of Oppenheimer, Wolff & Donnelly LLP
for Gruber Systems, Inc.

Lauren B. Cohen for Grantex Surface Systems.

Before Hohein, Bottorff, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Grantex Surface Systems (applicant) has applied to
register the mark "GRANTEX SURFACE SYSTEMS" for goods
ultimately identified as "decorative surface coatings in
the nature of a quartz-like finish for use on concrete

surfaces and a variety of indoor and outdoor walls" in International Class 2."¹

Gruber Systems, Inc. (opposer) has opposed registration on the ground that applicant's mark, when used on or in connection with the identified goods, so resembles opposer's previously used and registered mark "GRANATEX" for "filler material made of polymers and inorganic fillers that is mixed with resins and cast to form a final product used in making counters for kitchens, bathroom fixtures, furniture and architectural products" in International Class 17² as to be likely to cause confusion or mistake or deception. Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the file of the involved application; the trial testimony deposition, with accompanying exhibits, of John D. Hoskinson, opposer's president; the trial testimony deposition, with accompanying exhibits, of Lawrence Benforado, president

¹ Serial No. 75/451,964, filed March 17, 1998, which is based on an allegation of a bona fide intention to use the mark in commerce. The words "surface systems" are disclaimed.

² Registration No. 1,739,837, issued December 15, 1992; Section 8 and 15 affidavits accepted and acknowledged, respectively.

of 46 Enterprises Incorporated³; and the trial testimony deposition of Mark Cagni, a manager for Peter Brown Construction.

Both parties have filed briefs, but no oral hearing was requested.

Priority

Opposer alleges that it is the owner of Registration No. 1,739,837 and has attached to its pleading a copy of that registration and a copy of the respective acknowledgement and acceptance of the Section 8 and 15 affidavits by the Patent and Trademark Office. See Notice of Opposition, Exhibits A and B. However, opposer has not submitted a title and status copy of the registration in accordance with the Trademark Rules.⁴ In

³ While the application was filed in the name of Grantex Surface Systems, at trial it became clear that Grantex Surface Systems is a division of 46 Enterprises Incorporated. Benforado Dep., pp. 5-6. Filing an application in the name under which an applicant does business or in the name of an operating division is a correctable error. TMEP § 1201.02(c)(1) and (2). Should applicant ultimately prevail, it should file the appropriate paper to correct the name of the applicant.

⁴ Trademark Rule 2.122(d) provides that:

(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals and photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

this case, applicant put opposer on notice that opposer needed to prove its ownership of its registration when applicant answered

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original and photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

opposer's allegations of ownership of a registration with a statement that applicant "neither admits nor denies the allegations contained in paragraphs 4, 5, 6, and 7, but leaves Opposer to its proofs." Answer, ¶ 3. Since opposer did not provide status and title copies of its registration or any other similar evidence, it cannot rely on its ownership of a registration to meet its prima facie case of likelihood of confusion.

However, opposer has submitted evidence that establishes its common law rights in the mark GRANATEX for its filler material made of polymers and inorganic fillers that is mixed and cast to form a final product used in making counters for kitchens, bathroom features, furniture and architectural products, which predate either applicant's filing date or any first date of use that applicant can establish for its mark, GRANTEX SURFACE SYSTEMS. Opposer's president has testified that "the first application of the product and the trademark Granatex did not happen until approximately 1987." Hoskinson dep. at 7. Opposer submitted an invoice from 1993 involving a shipment of GRANATEX 500 from the United States to Curacao, apparently the island in the Caribbean. Opposer's Exhibit 1.⁵ Opposer's president

⁵ The address is:

testified that the shipment would have been "marked with the product name and nomenclature as Granatex 500."⁶

Hoskinson dep. at 9. This evidence establishes a date of first use of the mark in commerce of at least 1993. In addition, opposer's September 1999 GruberInk newsletter shows that opposer continues to use the mark GRANATEX in connection with its goods. Opposer's Exhibit 6 at GS00454. Inasmuch as applicant does not argue that it has an earlier date of first use,⁷ opposer has established that it has priority in this case based on its

Curacao Marble

Curacao, FG

FG may be an abbreviation for French Guinea, although the island of Curacao is in the Netherlands Antilles. It is not part of French Guinea. Opposer has also provided evidence that it shipped products identified as Grantex 300 in 1995 to Advanced Plastics in Nashville, Tennessee. This date is also sufficient to establish priority for opposer. There is a series of Granatex filler products identified by numbers, such as 600, 501, 500, 400, and 350. Opposer's Exhibit 8.

⁶ We note that opposer's president testified that "we don't always spell out the name "Granatex. We sometimes might put GTX as the description of the products on the box." Hoskinson dep. at 9-10.

⁷ While the application is an intent-to-use application, applicant's president, in response to a question from its attorney concerning when the mark GRANTEX was first used with the product, specified "December of 1996." Benforado dep. at 20. Applicant's president also corrected its response to an interrogatory concerning applicant's first use of its mark to make it clear that the year was 1996, not 1992. Benforado dep. at 20-21. However, applicant was also asked the following question:

Q. Approximately when or if you know the date, I'm not sure, if you don't know the date, then approximately when did you first use the mark Grantex as applied to the product you described or in any form did you use the mark?
A. The end of 1997.

common law rights in the mark GRANATEX for its filler products.

Facts

On March 17, 1998, applicant filed an application to register the mark GRANTEX SURFACE SYSTEMS for goods ultimately identified as "decorative surface coating in the nature of a quartz-like finish for use on concrete surfaces and a variety of indoor and outdoor walls."

After the application was published on February 23, 1999, opposer filed a notice of opposition. As discussed above, opposer has demonstrated that it is the prior user of the mark GRANATEX on filler material made of polymers and inorganic fillers that is mixed with resins and cast to form a final product used in making counters for kitchens, bathroom fixtures, furniture, and architectural products. In its promotional material, opposer's goods are described as follows:

Because it's a moldable and machinable polymer material, form can complement function, to create the decorative elements in a total bathroom design incorporating the fixtures themselves.

Suddenly, the limits on creative bathroom design disappear over the horizon.

Benforado dep. at 19.

Applicant has not established a date of first use in commerce earlier than the constructive date of first use established by its application's filing date (March 17, 1998).

Picture the potential for luxurious elegance:
Integral washbasin, bathtubs, showers, toilets and
bidets, wainscoating [sic] and windowsills, even
fireplace mantels, all with the textural sensation
of Granatex.

Opposer's Exhibit 11.

Opposer's president explained that its immediate customers are manufacturers who purchase Granatex material and then manufacture finished products with it. Hoskinson dep. at 32-33. "Most all the manufacturers tend to attend local home and garden shows." Hoskinson dep. at 34. These manufacturers also attend regional homebuilders shows attended by general contractors, specifiers, architects, developers, subcontractors and homeowners. Hoskinson dep. at 35. While these manufacturers do not promote the brand name GRANATEX, the product would be identified in the literature concerning the products these manufacturers use. Hoskinson dep. at 33. The Solure™ group is an example of an industry group that promotes GRANATEX. "To further ensure top quality products, all Solure Manufacturers use Granatex®, the top-of-the-line granite filler material." Opposer's Exhibit 20.

Opposer's president testified that it tries to advertise by pull-through advertising as opposed to push-down-the channel marketing. Pull-through advertising

involves going past the immediate customers, in this case the manufacturers of the products, to the ultimate consumers, in this case homeowners and building owners, to create a demand for the product. Hoskinson dep. at 41.

We try to do the same thing in a very narrow market where we promote into the specification community; go to the kitchen and bath show; go to the home builders show or co-op with our customers to have showrooms done or model homes using Granatex because we're aware of the fact that if we can create awareness on the part of the consuming community, it's our opinion that they'll have an interest in this product, and they will pull through as opposed to waiting for, say, a builder to decide he's going to standardly make it available.

Id.

Opposer relies heavily on consumers, builders, and architects to create a demand for its product. Hoskinson dep. at 43. Architects and others that specify the products to be used in a building project would find out about opposer's GRANATEX product through the ARCAT.COM website for the architectural community, through opposer's link with the International Cast Polymer Association, and through demand created by opposer's contacts with builders and customers. Hoskinson dep. at 25-26. Despite some other uses discussed in the deposition, opposer's "marketing strategies are to stay

pretty focused on interior applications in kitchens and bathrooms." Hoskinson dep. at 63.

Applicant, on the other hand, makes a product that coats or repairs a pre-existing surface. "A new way to repair and beautify old, damaged concrete, driveways, patios, pool decks, walkways, garage floors and any area that needs a new look." Opposer's Exhibit 14; Applicant's Exhibit 13.

Applicant's advertising states that GRANTEX is

- "the newest innovation to hit the market for surfacing and resurfacing of interiors and exteriors;"
- "goes right over river rock, spray decks, concrete, wood or key stone;" and
- "is an outstanding alternative to tile for Commercial Kitchen Walls."

Opposer's Exhibit 14; Applicant's Exhibit 13.

Applicant markets its product by direct mailing to architects and builders. Benforado dep. at 51. Its product is distributed through dealer/installers. Benforado dep. at 24. It mails its brochures (Opposer's Exhibit 14, Applicant's Exhibit 13) to "[h]omeowners, builders, decorators, architects." Benforado dep. at 38.

Likelihood of Confusion

We now address the question of whether there is a likelihood of confusion. The Court of Customs and Patent

Appeals, one of the predecessor courts of the Court of Appeals for the Federal Circuit, set out a non-exclusive list of thirteen factors to be considered when determining whether one mark is likely to cause confusion with another mark. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). We begin our discussion by analyzing the applicant's and opposer's marks under the du Pont factors that are at issue in this case.

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

Opposer is using the mark GRANATEX while applicant's mark is GRANTEX SURFACE SYSTEMS with the words "SURFACE SYSTEM" disclaimed. It is well settled that it is improper to dissect a mark and that marks must be viewed in their entireties. In re Shell Oil, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to a particular feature of a mark, provided that the marks are still considered in their entireties. In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). Applicant has, in effect, taken opposer's mark GRANATEX, deleted the second "a" and added the descriptive words "surface systems" to the mark. We believe that GRANTEX

is the dominant feature of applicant's mark, and the feature that potential customers are likely to remember. Applicant's brochure itself refers to the term "Grantex" eleven times. Opposer's Exhibit 14; Applicant's Exhibit 13. Ten times it is used without the words "surface systems." The only time it is used with "surface systems" is in the return address line where the words "surface systems" appear below the term "Grantex" in regular type while the word "Grantex" appears on the line above in much larger and multi-color type. Thus, GRANTEX would be the dominant part of applicant's mark. In re Dixie Restaurants, Inc., 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (holding that THE DELTA CAFE and design was confusingly similar to DELTA; more weight given to common dominant word DELTA). See also Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977)(CALIFORNIA CONCEPT and design likely to be confused with CONCEPT for hair care products).

Also, the presence or absence of the letter "a" in the middle of the mark does not significantly reduce the likelihood that the marks are likely to be confused. Consumers' memories are not perfect and they would have a hard time distinguishing between terms as similar as "Grantex" and "Granatex." Even considering the presence

of the additional words "surface systems," consumers would likely believe that applicant's mark merely identifies another product sold under the "Granatex" trademark.

Thus, the marks look and sound alike and they likely have the same meaning in that they imply or suggest granite or a granite-like appearance. Benforado dep. at 80 (Applicant's president acknowledged that one of the reasons applicant "chose [the mark] Grantex [was] because it looks like granite"); Opposer's Exhibit 20 ("Granatex® is the top-of-the-line granite filler material"); Opposer's Exhibit 8 ("Granatex 600 is a unique formulation used for spraying a granite-look product"). This du Pont factor favors opposer.

- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

Applicant's goods are identified as "decorative surface coatings in the nature of a quartz-like finish for use on concrete surfaces and a variety of indoor and outdoor walls." Opposer's products are filler material used to make counters for kitchens, bathroom fixtures, and architectural products. It is very clear that the products are not identical. Applicant's product is a relatively inexpensive surfacing material that is applied

over a preexisting material to repair or improve the surface of the material. Applicant's advertising emphasizes its use around pools, stairs, driveways, and similar areas.

Opposer's product, on the other hand, is a solid surface material primarily used to make counters and bathroom fixtures. Opposer's product is more expensive than applicant's and its primary use would not be to repair or improve the appearance of a pre-existing surface. Opposer has admitted that its product is primarily used in kitchens and bathrooms. Applicant's president, on the other hand, testified that: "We don't want the product in a situation or environment of a bathroom. We don't want to do bathrooms. A bathroom is [a] four-by-four shower. My dealers can't make any money doing showers. My product doesn't sell for \$100 a foot, it sells for five dollars a foot." Benforado dep. at 93-94.

Despite the obvious differences in the products and their cost, the goods are related. Both are marketed under similar conditions. The products are not sold directly to the ultimate purchaser, i.e., the building owner or builder. Instead they are sold to dealer/installers or manufacturers who would eventually

sell the product to the building owner or builder. Both would market their product in similar ways by attempting to create demand from homeowners, building owners, architects, and others who specify the products or materials used in a building project.

There is some dissimilarity between the specific trade shows attended by the parties. Opposer would attend the National Kitchen and Bath Show (Hoskinson dep. at 24); applicant would attend the National Pool and Spa Show and World of Concrete shows (Benforado dep. at 54-55). However, applicant's dealer/installers and opposer's manufacturers would attend home trade shows where applicant's and opposer's products or goods made from their products would be exhibited. Benforado dep. at 72; Hoskinson dep. at 34. Both applicant and opposer also target architects as individuals who they hope will specify their products in their projects. Hoskinson dep. at 24; Benforado dep. at 38; Cagni dep. at 14.

Thus, while the goods are not identical, they could be specified by the same individuals (architects) for the same job. Both products also have multiple uses. Both applicant and opposer leave it up to the manufacturers and dealers/installers to decide how the products are used. Thus, they have little control over where their

product will be used and to what uses their products will be put. While applicant's witness from the construction industry testified that "the two of the things are totally different. I don't think I would confuse the source or the use," (Cagni dep. at 12), it is also clear that when he used the GRANTEX SURFACE SYSTEM product, he did so because the project's architect specified it. Cagni dep. at 13. However, since the products would be marketed to architects, homeowners, and builders, they would likely assume that the product used as an exterior floor surface and the material for a counter or bathroom fixture for the same project, when sold under very similar trademarks, came from, or were associated with, the same source.

- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.

As explained above, both applicant and opposer ultimately market their goods to people who specify the components for a construction project (building owners, homeowners, and architects). Thus, while it is unlikely that the same party would install applicant's and opposer's products, the same ultimate customer may specify for, example, that, in a new home construction product, it wants GRANTEX SURFACE SYSTEMS on the driveway and around the pool and GRANTEX features and countertops

in the bathroom and kitchen. Thus, because these products would be marketed to the same consumers at the same time, this factor favors opposer.

- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

We agree with applicant that neither parties' goods are likely to be purchased on impulse, and therefore, this factor favors applicant.

- (5) The fame of the prior mark (sales, advertising, length of use).

We reject opposer's argument that "Gruber has been using GRANATEX for 13 years, which causes fame." Opposer's evidence of fame is, at best, de minimis. It presented no evidence of volume of sales, market penetration, and advertising expenditures. Thus, this factor does not support opposer's argument concerning likelihood of confusion.

- (6) The number and nature of similar marks in use on similar goods.

Applicant's trademark search results are not evidence of use and, therefore, there is no evidence of third-party use of similar marks on similar goods. Therefore, this factor would favor opposer.

- (7) The extent of potential confusion, i.e., whether de minimis or substantial.

If the products were marketed on a national scale, the potential of confusion would be substantial because the ultimate purchasers or specifiers of these products would likely associate them with a single source.

- (8) Any other established fact probative of the effect of use.

There is no other established probative fact.

Opposer's argument that one product contains health warnings and the other does not is not a significant factor in a likelihood of confusion analysis. The first level purchasers of the products, manufacturers and dealer/installers, would be expected to read and observe health and safety warnings.

Application of the Likelihood of Confusion Factors

After we balance the du Pont factors, we conclude that there is a likelihood of confusion. Likelihood of confusion is decided upon the facts of each case. Dixie Restaurants, 105 F.3d at 1406, 41 USPQ2d at 1533; Shell Oil, 992 F.2d at 1206, 26 USPQ2d at 1688. The various factors may play more or less weighty roles in any particular determination of likelihood of confusion. Shell Oil, 992 F.2d at 1206, 26 USPQ2d 1688; du Pont, 476 F.2d at 1361, 177 USPQ at 567.

Here, we first note that the marks are very similar. Even the addition of the term "surface systems"

reinforces, instead of reduces, the likelihood of confusion. Architects and other specifiers who are familiar with opposer's GRANATEX countertops and similar products are likely to believe that GRANTEX SURFACE SYSTEMS is simply a new product from the original source. The slight difference between the common portions of the marks, GRANATEX and GRANTEX, would be difficult for most consumers to distinguish. Therefore, in order to determine if confusion is likely, we must next look at the parties' goods.

In order to support a determination that the goods are related, it is not necessary that respective goods be identical or even competitive. If the goods are marketed in such a way that would lead customers to a mistaken belief that they originate from or are in some way associated with the same producer or that there is some association or connection between the producers of the respective goods, the goods are related. Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In this case, the goods are marketed to the same ultimate consumers or specifiers. Applicant's goods can be used on floors and walls and indoors and outdoors.

Opposer's publications indicate that its products are used in kitchen and bathroom countertops, shower pans, shower surrounds, flooring, and columns. See Opposer's Exhibits 4 and 5; Applicant's Brief at 10-11 (listing goods in opposer's exhibits). Neither party's goods are confined to a specific use or type of product.

Applicant's brochure shows or describes a multitude of uses including stairs, marinas, pool and spa areas, porches, patios, walkways, garage floors, commercial kitchen walls, and "any area that needs a new look."

Opposer's Exhibit 14; applicant's Exhibit 13 ("[T]he newest invention to hit the market for surfacing and resurfacing exterior and interiors"). Opposer's newsletter similarly describes a multitude of uses of its products. Opposer's Exhibit 6. Opposer does not control the products that can be made from its goods, and applicant does not limit the uses of its materials.

Under these circumstances, with a dynamic market for its multi-use goods, confusion is more likely as the products are actually used in homes and other buildings. Both products are likely to be encountered by the same ultimate consumers, who are likely to attribute a common source to applicant's and opposer's goods sold under the marks GRANATEX and GRANTEK SURFACE SYSTEMS.

While we note that there is no actual confusion in this case, this is not a prerequisite for establishing a likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Smack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). In this case, where there has been no showing of extensive marketing of the products sold under the respective marks, it is not surprising that there was no evidence of actual confusion. We also have little evidence that would support giving the GRANATEX mark only a narrow scope of protection. Even if it were weak, professional purchasers are likely to assume that the products of applicant and opposer, when they are sold with such similar marks, come from the same source. Octocom Systems Inc. v. Houston Computer Services, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

We certainly do not hold that all products purchased or specified by architects or homeowners are related products. Our decision in this case is based upon the specific goods of the parties. Opposer is not selling sinks and bathroom fixtures. It is selling a solid surface product that can be put to various uses including countertops, sinks, shower pans, and even such uses as

flooring and columns. Applicant is selling a coating or surfacing material that can be used in "any area that needs a new look." About the only limit on applicant's product is the willingness of a dealer/installer to do a job that applicant may consider to be too small (Benforado dep. at 101-102) and, for opposer's product, the limit of its uses seems to be the willingness of the ultimate consumer to pay for the added cost of its materials (Hoskinson dep. at 75-76 (Spa manufacturer evaluating cost effectiveness of using GRANATEX for spas)). Thus, with the many and varied uses of these products and the close similarity of the marks, we find that there would be a likelihood of confusion when the mark GRANTEX SURFACE SYSTEMS is used on decorative surface coatings in the nature of a quartz-like finish for use on concrete surfaces and a variety of indoor and outdoor walls and the mark GRANATEX is used on filler material made of polymer and inorganic fillers that is mixed with resins to form a final product used in making counters for kitchens, bathroom fixtures and architectural products.

Decision: The opposition is sustained and registration to applicant is refused.